

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM L. PARISH JR., PHILLIP G. MARTIN and
PATRICK D. HYDE

Appeal No. 1999-0687
Application 08/560,315

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 36, 38, 41-55, 57, 58 and 68-72, all the claims remaining in the present application. Previously appealed claims 37, 56 and 59-67 have been canceled by appellants. Claim 36 is illustrative:

36. A method of adhering a lens block to a compound surface of an ophthalmic lens blank,

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comprising the steps of:

applying the pressure-sensitive adhesive portion of a section of a conformable tape to the entirety of a compound surface of an ophthalmic lens blank, wherein the tape comprises a polymer backing having a first and a second major surfaces; and a pressure-sensitive adhesive on the second major surface of the polymer backing, wherein the tape is wound into a roll without a liner and exhibits a maximum unwind force of less than 165 g/cm width;

conforming the tape to the surface so that the tape is essentially free from wrinkles, air bubbles and other discontinuities in the bond between the tape and the lens blank; and

applying a lens block to at least a portion of the polymer backing layer of the tape.

The examiner relies upon the following references as evidence of obviousness:

Ohno et al. (Ohno)	4,636,427	Jan. 13, 1987
Sipinen et al. (Sipinen)	4,769,283	Sep. 06,
1988		
Ohlin, Jr. (Ohlin)	5,343,657	Sep. 06, 1994

Appellants' claimed invention is directed to a method of adhering a lens block, such as a metal coating, to the surface of an ophthalmic lens blank. The method entails employing a tape comprising a polymer backing and a pressure-sensitive adhesive on

the polymer backing. The tape is defined as a roll of tape

that

"is wound into a roll without a liner and exhibits a maximum unwind force of less than 165 g/cm width" (claim 36). Claim 38, the other independent claim on appeal, does not recite that the tape is wound into a roll without a liner and does not refer to

any maximum unwind force. Rather, appealed claim 38 "defines a tape featuring a multi-layered backing that includes an outer surface layer and a core layer selected from certain types of polymers that likewise contributes to realizing the aforementioned advantages" (page 3 of principal brief).

Appealed claims 36, 41-47, 49-55 and 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohlin in view of Sipinen. Claims 38, 48, 57 and 68-72 stand rejected under 35 U.S.C. § 103 as being unpatentable over the stated combination of references in further view of Ohno.

Upon careful consideration of the opposing arguments presented on appeal, we find that the prior art applied by the examiner fails to establish a *prima facie* case of obviousness for the claimed subject matter. Accordingly, we will not

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sustain either of the examiner's rejections.

We consider first the examiner's rejection of claim 36 and the claims dependent thereon over Ohlin in view of Sipinen.

Appellants are on record as stating that the conventional tape 20 employed in the process of Ohlin, e.g., a tape sold by Venture Tape Corp., utilizes a liner in contrast to the tape utilized in the method of claim 36. Ohlin, itself, is silent regarding the use of a liner. Also, Ohlin does not disclose the claimed maximum unwind force. To remedy this deficiency in Ohlin, the examiner relies upon Sipinen and concludes that "it would have been obvious to one of ordinary skill in this art to employ the tape of Sipinen et al. in the process of Ohlin in the place of the corresponding, analogous tape employed therein . . . mere substitution of one known conformable PSA tape for another involved" (page 5 of answer). However, as emphasized by appellants, Sipinen is directed to pressure-sensitive adhesive tapes that are useful for fasteners on disposable diapers, and the reference provides no teaching or suggestion that the

disclosed tape can be used in a method of adhering a lens block to a lens blank as disclosed in Ohlin and presently claimed. For

this reason, we must agree with appellants that there is no factual basis for concluding that it would have been obvious for one of ordinary skill in the art to substitute the tape of Sipinen for the tape used in the process of Ohlin.

The examiner's rejection of claims 38 and the claims dependent thereon is similarly flawed. While Ohno discloses a multilayer backing in the formation of a pressure-sensitive adhesive tape, Ohno is directed to methods for binding packages

and masking. Hence, even if it were obvious for one of ordinary skill in the art to modify the tape of Sipinen in a multi-layer fashion of the type disclosed by Ohno, as proposed by the examiner, there remains no factual basis for substituting the modified tape of Sipinen in the method of Ohlin for adhering a lens block to a lens blank.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

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REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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